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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/707,309	12/04/2003	Fred Bishop	03292.101680.1	1308
66569 7590 04/16/2008 FITZPATRICK CELLA (AMEX) 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			EXAMINER SHAH, AMEE A	
			ART UNIT 3625	PAPER NUMBER
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/707,309	<b>Applicant(s)</b> BISHOP ET AL.	
	<b>Examiner</b> Amea A. Shah	<b>Art Unit</b> 3625	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

Claims 1-17 are pending in this action.

#### ***Response to Amendment***

Applicant's Amendment and Remarks, filed April 9, 2007, have been entered. Claims 1, 6 and 12 have been amended. Claim 18 has been withdrawn. In view of the amendments to the specification, the objections regarding trademark usage are withdrawn.

#### ***Examiner Note***

Examiner cites particular columns and line numbers in the references as applied to the claims below for the convenience of the applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested that, in preparing responses, the applicant fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

#### ***Claim Rejections - 35 U.S.C. § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter

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as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. §103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. §103(c) and potential 35 U.S.C. §102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

**Claims 1-17 are rejected under 35 U.S.C. §103(a) as being unpatentable over Angles et al., US 6,385,591 B1, cited in the previous Office Action (hereafter referred to as “Angles”) in view of Greenberg, US 2003/0144913 A1 (hereafter referred to as “Greenberg”) and further in view of Hartman et al., US 5,960,411 (hereafter referred to as “Hartman”).**

Referring to claim 1.

Angles teaches a method performed by an interface device for facilitating interaction between a consumer and a merchant (*see, e.g.*, Figure 3). Angles teaches an advertisement provider, which could be a computer, server or program (col. 13, lines 34-59), as the interface device as defined by the applicant (specification, ¶0017), receiving offer information from a content provider, i.e. merchant, via an electronic page or interactive television page with an embedded advertisement request, i.e. a broadcast that reaches a plurality of potential consumers,

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wherein said offer information relates to a product (*e.g.* Fig. 3, col. 7, line 65 through col. 8, line 43 and col. 9, lines 37-44). Angles further teaches the advertisement provider retrieving consumer preference information from a demographic database associated with the consumer (*e.g.* Fig. 3, col. 8, lines 19-24 and line 61 through col. 9, line 1, and col. 19, lines 53-63), amending the electronic page with an advertisement customized according to the consumer preference information, i.e. customizing the offer information received from the merchant via the broadcast according to the consumer preference information to create an amended offer for the consumer (*e.g.* Fig. 3, col. 8, lines 24-30, col. 9, lines 1-4 and col. 20, line 60 through col. 21, line 18), and transmitting the amended offer to a display for viewing by the consumer (*e.g.* Fig. 3, col. 8, lines 28-30 and col. 9, lines 5-10).

Greenberg, in the same field of endeavor of electronic shopping, teaches a method and apparatus for conducting electronic commerce where an email offer is sent to prospective customers, such offer specifying a method of acceptance (Fig. 2 and pages 1-2, ¶¶0016 and 0018 – note the method of acceptance is the “Purchase ‘button’”), an acceptance is received from the consumer, wherein the acceptance is associated with the offer and the acceptance includes a security feature of an identifier transmitted from a communication device used to perform the acceptance (Figs. 2 and 3, and page 2, ¶0018 – note the security feature can be either the one embedded on a credit card or the SSL handshaking and certificate exchange, both identifiers and which can be transmitted from a communication device such as a computer), the acceptance is amended with consumer payment information and identification information to create an amended acceptance (page 2, ¶0021 – note the consumer payment information and identification

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are in the email in advance and the amended acceptance is performed by activating the "Purchase Using Default Options" button); and the amended acceptance is transmitted to the merchant (Fig. 3 and page 2, ¶¶0019 and 0021 – note the transmittal is performed by notifying the merchant server).

Hartman, in the same field of endeavor of electronic shopping, teaches a method and apparatus for placing an order to purchase by "one-click shopping" (see, e.g., Abstract). Hartman teaches storing by a server, i.e. an interface device, consumer payment information and identification information in a database (Figs. 2 and 3, col. 5, line 59 through col. 6, line 4 and col. 6, lines 48-50), retrieving by the interface device consumer payment information and consumer identification information from a database associated with the consumer (Fig. 3 and col. 6, lines 52-67) and amending by the interface device the acceptance with the consumer payment information and the consumer identification information to create an amended acceptance upon receipt of the acceptance from the consumer by the interface device (Fig. 5 and col. 7, lines 25-30 – note the acceptance from the consumer is the single action needed to place the order).

It would have been obvious to one of ordinary skill in the art of business methods at the time of the invention to combine the known elements of specifying a method of acceptance, receiving an acceptance associated with the offer and with a security feature, amending the acceptance with payment and identification information and transmitting the amended acceptance to the merchant, as taught by Greenberg, with the known elements of an interface

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device retrieving consumer payment and identification information and amending the acceptance with this information, as taught by Hartman, with an interface device receiving offer information, customizing the offer information according to consumer preference information and transmitting the amended offer to the consumer, as taught by Angles, as each element would have performed the same function in combination as it did separately. One ordinary skill in the art would have recognized that the combination of Greenberg, Hartman and Angles would yield the predictable results of allowing for an electronic purchase to be more simply conducted after an offer to sell is made, thereby leading to more business transactions completed and more profit.

Referring to claim 2. Angles in view of Greenberg and Hartman further teaches the method of claim 1 wherein the step of transmitting the amended offer to a display includes transmitting via at least one of television programming and an Internet broadcast (Angles, col. 9, lines 37-44).

Referring to claim 3. Angles in view of Greenberg and Hartman further teaches the method of claim 1 wherein the consumer preference information includes at least one of restriction information, demographic information, identification information, and shipping information (Angles, *e.g.*, col. 17, lines 15-22).

Referring to claim 4. Angles in view of Greenberg and Hartman further teaches the method of claim 1 wherein the step of receiving an acceptance from the consumer includes receiving an acceptance via at least one of a remote control, an electronic pen, a telephone, an

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automatic dialing device, a microphone, a pager, a radio-frequency device, a personal digital assistant, a smart card, DVR, PVR, and simulated button (Angles, col. 10, lines 43-52 and Greenberg, pages 1-2, ¶0016 – note the computer can be a number of mechanisms, including a personal digital assistance, interactive television and wireless device, and that the acceptance can be any mechanism, including a mouse click, to indicate acceptance) in order to complete and effect a purchase.

Referring to claim 5. Angles in view of Greenberg and Hartman teaches the method of claim 1 wherein the acceptance includes a security feature including at least one of authentication, embedded certificate, consumer ID and password, identifier, data-encryption information, digital signature, secure file structures, and trusted third party downloads (Greenberg, Figs. 2 and 3, and page 2, ¶¶0018, 0021 and 0022 – note the security feature can be consumer ID and password, the one embedded on a credit card or the SSL handshaking and certificate exchange). It would have been obvious to one of ordinary skill in the art of business methods at the time of the invention to combine the known elements of a security feature to an acceptance, as taught by Greenberg, with the known elements of an interface device receiving offer information, customizing the offer information according to consumer preference information and transmitting the amended offer to the consumer, as taught by Angles, as each element would have performed the same function in combination as it did separately. One ordinary skill in the art would have recognized that the combination of Greenberg and Angles would yield the predictable results of preventing fraudulent purchases and/or uses of credit cards.



Referring to claim 6. Angles in view of Greenberg and Hartman also teaches the method of claim 1 wherein the consumer preference information, consumer payment information and consumer identification information are provided to at least one database in a registration process performed by the consumer (Angles, col. 14, lines 22-63 and col. 17, lines 1-51 and Hartman, col. 6, lines 48-60).

Referring to claim 7. Angles in view of Greenberg and Hartman also teaches the method of claim 1 further comprising the steps of authenticating the consumer (Angles, col. 19, lines 53-63 – note the authentication is extracting the consumer code and determining whether the user has registered), and managing consumer identities (Angles, *e.g.*, col. 16, lines 10-19 – note the management of consumer identities is the storing of information based on the consumer code).

Referring to claim 8. Angles in view of Greenberg and Hartman also teaches the method of claim 1 further comprising the step of analyzing attributes of the consumer to substantially predict an optimal offer content and context (Angles, *e.g.*, col. 16, lines 10-19 – note the analysis is based on consumer profile).

Referring to claim 9. Angles in view of Greenberg and Hartman further teaches the method of claim 1 wherein the step of amending includes amending the acceptance with at least one of consumer loyalty point information, authorization from an issuer, authorization from said system, security or wallet server authorization, consumer authentication and single use account number information (Greenberg, page 2, ¶0021 – note the acceptance includes authorization

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from user, security server authorization and single use account number information from credit card). It would have been obvious to one of ordinary skill in the art of business methods at the time of the invention to combine the known elements of amending the acceptance with authorization, as taught by Greenberg, with the known elements of an interface device receiving offer information, customizing the offer information according to consumer preference information and transmitting the amended offer to the consumer, as taught by Angles, as each element would have performed the same function in combination as it did separately. One ordinary skill in the art would have recognized that the combination of Greenberg and Angles would yield the predictable results of completing transactions in a timely manner.

Referring to claim 10. Angles in view of Greenberg and Hartman also teaches the method of claim 1 further comprising the step of developing at least one of a consumer transaction database and an offer evaluation database (Angles, col. 16, lines 10-20).

Referring to claim 11. Angles in view of Greenberg and Hartman further teaches the method of claim 1 wherein the step of transmitting the amended acceptance to the merchant includes at least one of authenticating the consumer and authorizing a transaction between the consumer and the merchant (Greenberg, Fig. 3 and page 2, ¶¶0019 and 0021). It would have been obvious to one of ordinary skill in the art of business methods at the time of the invention to combine the known elements of authenticating the consumer and authorizing a transaction, as taught by Greenberg, with the known elements of an interface device receiving offer information, customizing the offer information according to consumer preference information

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and transmitting the amended offer to the consumer, as taught by Angles, as each element would have performed the same function in combination as it did separately. One ordinary skill in the art would have recognized that the combination of Greenberg and Angles would yield the predictable results of completing the transaction.

Referring to claims 12, 13, and 15-17. All of the limitations in apparatus claims 12, 13, 16 and 17 are closely parallel to the limitations of method claims 1-11, analyzed above and are rejected on the same bases.

Referring to claim 14. Angles in view of Greenberg and Hartman also teaches the interface device of claim 12 wherein the application program causes the processor to perform a step of storing the offer information in an offer database (Angles, col. 12, lines 1-11 – note the offer database is the advertising storage medium).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1-17 have been considered but are moot in view of the new ground(s) of rejection.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amee A. Shah whose telephone number is 571-272-8116. The examiner can normally be reached on Mon.-Fri. 7:00 am - 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeffrey A. Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Jeffrey A. Smith/  
Supervisory Patent Examiner, Art Unit  
3625

AAS

April 4, 2008